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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/571,070	03/08/2006	Hiroshi Sato	040894-7418	2394
9629 7590 05/28/2009 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004				
EXAMINER				
ESTREMSKY, GARY WAYNE				
ART UNIT		PAPER NUMBER		
3677				
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05/28/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/571,070

**Applicant(s)**

SATO, HIROSHI

**Examiner**

Gary Estremsky

**Art Unit**

3677

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date herein

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/25/09 has been entered.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,086,304 to Hujishima in view of JP-A-165256 and JP-A-199123.

3. Hujishima '304 teaches Applicant's claim limitations including : a "number of staple members" – 1, a "tearable film" including 12, "is adhered to a center portion of a staple member which does not constitute a leg after the staple member is formed" – inasmuch as the limitation is phrased functionally as part of some intended use, it can be relied on only so far as it clearly defines structure of the product that is claimed as

the invention. In that respect, the product now claimed as the invention is not required to have legs that are bent from a center portion and does not clearly require the film to be on only one or more particularly only a specific one of the sides of the aligned staples. As the invention is defined in the claims, a film is required to be on a center portion of a staple member. Though reference recites film being arranged at a portion of the staple that will become the inner side of a crown portion when it is bent, the claimed invention does not require the staple to actually be bent whereby the limitation amounts to little more than a statement of intended use. It is examiner's position that the prior art discloses a film adhered to a center portion of the aligned staples and discloses portions of the staple on either side of the film (as shown on the face of the Patent), that are inherently capable of being formed into legs not having film adhered thereto; the legs extending upwards from the side having the film whereby the film is at the inner side of the crown.

4. Regardless, it should be noted that the reference explicitly discloses that the film is "designed to be located at the under surface of the middle portion 3 of a U-shaped staple 1 when the staple 1 is driven out. Therefore advantageously, the staple 1 is superior in external appearance, and there is no fear that the film will peel off later. The film is caused to be adhered to the middle portion 3 of the staple 1 so as not to extend to the leg portions 2 thereof.". One of ordinary skill in the art would recognize there is no fear that the film will peel off when it is clamped between the crown portion of the staple and the top surface of a plurality of papers for example. In any case however,

the structure of the prior art staple and film are inherently capable of arrangement as recited.

5. Although the reference describes the use of any one of several tearable films (in the alternative), it does not describe the film is being laminated from porous film as now claimed. However, such technique is well known to those of ordinary skill in the tearable film art as shown by Japan '256 and Japan '123 for example. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the film or Japan '235 using lamination technique as disclosed by Japan '256 and Japan '123 in order to provide a film that is easy to tear using well known material. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

6. As regards claim 2, Japan '235, as relied on, discloses hole size and spacing are well known in the art.

7. As regards claims 4,6, inasmuch as the reference, as relied on, describes the structure as claimed, further recitation of the process that produces the claimed structure does not clearly further define any further particular structure of the claimed invention that can be relied on to patentably distinguish from the structure of the prior art. Inasmuch as a product claim is defined by its structure, such a claim including a product-by-process limitation is interpreted as including the structure formed by the process, not as a method step (as it would be in a process of making-type claim). In any case, reference discloses manufacture technique that reads on process.

8. Reference illustrates straight shape of staple where it is intended to be bent later as part of its intended use.

9. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-A-10-009235 in view of JP-A-165256 and JP-A-199123.

10. Japan '235 teaches Applicant's claim limitations including : a "number of staple members" – 1, a "tearable film" including 12, "is adhered to a center portion of a staple member which does not constitute a leg after the staple member is formed" – inasmuch as the limitation is phrased functionally as part of some intended use, it can be relied on only so far as it clearly defines structure of the product that is claimed as the invention. The present invention includes a number of staple members as otherwise defined in the claim but does not positively recite the C-shape staple that might be formed from the staple member at some later time. In that respect, the product now claimed as the invention is not required to have legs that are bent from a center portion and does not clearly require the film to be on only one or more particularly only on a specific one of the sides of the aligned staples. As the invention is defined in the claims, a film is required to be on a center portion of a staple member. The reference illustrates film being arranged at a center portion of the aligned staples and illustrates staple portions without film extending outwards to either side wherein those portions are inherently capable of being bent upwards (direction of a side having film) to become legs and thereby anticipates broad functional limitation.

11. . Although the reference does not illustrate the film is laminated from porous film as claimed, such technique is well known to one of ordinary skill in the tearable film art as shown by Japan '256 and Japan '123. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the film of Japan '235 using lamination technique as disclosed by Japan '256 and Japan '123 in order to provide a film that is easy to tear using known methods of manufacture.

12. As regards claim 2, Japan '235, as relied on, discloses hole size and spacing are well known in the art.

13. As regards claims 4, 6, inasmuch as reference, as relied on, describes the structure as claimed. In this case, further recitation of the process that produces the claimed structure does not clearly further define any particular structure of the claimed invention that can be relied on to patentably distinguish from the structure of the prior art. Inasmuch as a product claim is defined by its structure, such a claim including a product-by-process limitation is interpreted as including the structure formed by the process, not as a method step (as it would be in a process of making-type claim). In any case, reference discloses manufacture technique that reads on process.

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive. The scope of the claim as now written has been carefully considered. The claim does not positively recite the C-shape staple. Instead, it's functionally recited as part of an intended use of the claimed invention insofar as the staple members of the invention

might later be formed into a C-shape having the recited features. The prior art is inherently capable of the recited arrangement. Furthermore, the Hujishima '304 reference explicitly describes the arrangement. Though not relied on presently, the Lerner '445 also discloses that it's well known to provide the film on the inside of the crown, though that reference does disclose bits of the film to be on upper portions of the leg also. See Fig 6 for example. The grounds of rejection applied above relies on case law. The claimed material of the film is well known to those of ordinary skill in the art whereby it has been held to be within the skill of one having ordinary skill in the art at the time of the invention to substitute materials in order to attain particular benefits and/or tradeoffs associated with a given material. Otherwise Applicant argues pulling out tape does not anticipate film but does not provide sound basis as to such conclusion. In response to Applicant's arguments about film not being on areas of the staple member that may later be formed into legs of a C-shaped staple, the subject limitation is considered more fully in the grounds of rejection. Essentially that limitation is more relevant to intended use of the claimed invention than to clearly patentably distinguishing the claimed staple members from those of the prior art. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is 571 272-7055. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached on 571 272-6987. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gary Estremsky  
Primary Examiner  
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